

### **REMARKS**

As a result of amendment, claims 1-9, 14, 15, 17, 19-49, 64-69, and are now pending in this application. Of these, all but the new claims 65-69 stand rejected as obvious under 35 USC §103. Exemplary support for new claims 65-69 is found at page 6, line 21 – page 7, line 9 and page 8, lines 17-23. Thus, no new matter has been added.

A detailed response to the rejections follows. However, applicant reserves all applicable rights not exercised in connection with this response, including, for example, the right to swear behind one or more of the cited references, the right to rebut any tacit or explicit characterization of the references, and the right to rebut any asserted motivation for combination. Applicant makes no admission regarding the prior art status of the cited references, regarding them only as being of record in the application.

#### **Response to Non-consideration of Cited References**

Applicant submitted an Information Disclosure Statement and a 1449 Form on October 9, 2003. The Examiner returned a copy of the 1449 Form, acknowledging consideration of some of the references and indicating via strikeouts that 11 others were not considered. No explanation was given as to why these references were not considered.

Accordingly, applicant submits respectfully for consideration duplicate copies of the Information Disclosure Statement and copies of the 11 unconsidered cited references. Applicant requests respectfully that an initialed copy of the 1449 Form be returned with the next communication, acknowledging consideration of the 11 references.

#### **Response to §103 Rejections**

The Action includes three sets of rejections under 35 USC §103-- all based in whole or in part on a proposed combination of Sotomayor (U.S. 5,708,825) and Kanoh (U.S. 5,873,077). Specifically, claims 1-9, 14, 17, 19-26, 28, 31-38, 41-49 and 64 were rejected as unpatentable over Sotomayor and Kanoh (U.S. 5,873,077). Claims 15 and 29-30 were rejected as unpatentable over the Sotomayor-Kanoh combination as applied to claim 14, and further in view of Rodkin. (U.S. 6,092,074). And, claims 27-28 and 39-40 were rejected as unpatentable over the

Sotomayor-Kanoh combination as applied to claims 1 and 17, and further in view of Wolfe (U.S. 6,263,351).

In making the rejections, the Examiner conceded that Sotomayor does not teach “a URL including at least a portion of one of the marked portions,” but argues that Kanoh teaches an http query element at col. 8, lines 53-64 and that “it would have been obvious at the time of the invention (before January 1999) to include this teaching in Sotomayor because it would have provided the enhanced ability for efficiently performing a search based on search terms on the searched documents.” (Action, page 4.)

However, the Action fails to cite any objective evidence to support this proposed combination. The law requires that to establish a prima facie case of obviousness, the Examiner must provide some objective teaching or suggestion in the art to support the combination. More precisely, MPEP 2143.01 states that “the prior art [not the examiner] must suggest the desirability of the claimed invention.” In the present Action, there is nothing cited within the prior art to evidence any desirability of replacing Sotomayor’s hyperlinks with Kanoh’s http queries.

More importantly, it appears that one of skill without hindsight would not have recognized any desirability of replacing Sotomayor’s hyperlinks with Kanoh’s http queries. In fact, it appears that making this replacement would destroy Sotomayor’s function.

Sotomayor’s function is to create a “hyper index” (that is, a hyperlinked index) for a given document. According to Sotomayor, creating the hyper index entails automatically identifying key topics and phrases in a document’s text, defining one or more summary (or index) pages having key topic lists, and automatically generating hyperlinks from listed key topics to the key topics in the document’s text. (See, for example, abstract.) Thus, Sotomayor’s hyperlinks link from listed topics directly to specific locations in the document text.

On the other hand, Kanoh’s http queries link to a search engine, which conducts a keyword search using the term in the URL and if successful returns a set of relevant documents. Thus, if one --without hindsight-- were to replace Sotomayor’s links with Kanoh’s http query links, Sotomayor’s hyper index would not link the topics in the index back to the place where

they occurred in the document text, but instead to other documents. Thus, the proposed replacement would destroy the function of Sotomayor's hyper index.

In articulating the law, the MPEP states at 2143.01 that "[if] the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." Thus, in the present case, there is no suggestion or motivation to make the proposed combination of Sotomayor and Kanoh.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §103 rejections based on the proposed Sotomayor-Kanoh combination.

### CONCLUSION

In view of the foregoing remarks, applicant requests respectfully that the Examiner reconsider and withdraw the rejections. Further, applicant invites the Examiner to telephone its patent counsel at (612) 349-9593 to resolve any remaining issues which delay allowance.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

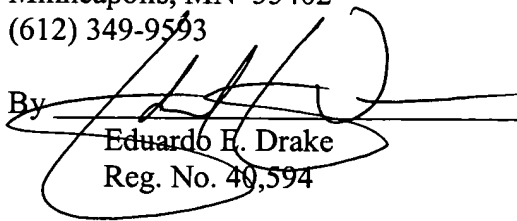
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By their Representatives,

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Date 15 Dec. 2004

By

  
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**AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111**

Serial Number: 09/237,219

Filing Date: January 25, 1999

Title: SYSTEM, METHOD, AND SOFTWARE FOR INSERTING HYPERLINKS INTO DOCUMENTS

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 15<sup>th</sup> day of December, 2004.

Eduardo Drake

Name

[Signature]

Signature